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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056168
Party	Plaintiff Legend Pictures LLC
Correspondence Address	CARLA CALCAGNO CALCAGNO LAW PLLC 2300 M ST NW, SUITE 800 WASHINGTON, DC 20037 UNITED STATES Carla.calcagno@calcagnolaw.com
Submission	Motion to Compel Discovery
Filer's Name	Carla C. Calcagno
Filer's e-mail	cccacagno@gmail.com
Signature	/Carla C. Calcagno/
Date	05/30/2013
Attachments	Exhibits to Petitioner's Motion To Compel F-G.pdf(3028655 bytes ) Exhibits to Petitioner's Motion To Compel H.pdf(3585242 bytes ) Exhibits to Petitioner's Motion To Compel I-J.pdf(5364420 bytes )

## EXHIBIT F

Date \_\_\_\_\_

CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of April 2013, a true and complete copy of the foregoing REGISTRANT'S OBJECTION TO LEGEND PICTURES, LLC's FIRST & SECOND SET OF INERROGATORIES (Cancellation No. 92056168) was served to Petitioner via electronic mail to:

Carla Calcagno at e-mail addresses:

carla.calcagno@calcagnolaw.com

and

cccalcagno@gmail.com

Calcagno Law  
2300 M Street, N.W., Suite 800  
Washington, D.C. 20037

/Gloria Walters/

Gloria Walters

Administrative Assistant to the Registrant

P.O.Box 47893

Tampa, Florida 33646



## EXHIBIT G

## REGISTRANT'S INITIAL CORRESPONDENCE TO RESOLVE DISCOVERY DISPUTE

Ms. Calcagno,

I have received the written e-mail correspondence of which you referred to in closing as your "good faith effort to resolve this discovery dispute". In spite of the fervent vehemence it did contain, accompanied with the exorbitant, over two week (sixteen days to be precise) lack of response to the objections it addressed, I do hereby respectfully respond as well as offer a peaceful and reasonable remedy to you.

In your correspondence you did;

1. "Demand" that I withdraw what you referred to as my "spurious" and "baseless" and "evasive" objection,
2. "Demand" that I answer the objected interrogatories and accompanying document requests you served,
3. Reference Trademark Rule 2.120(d)(1) & TBMP 405.03(d),
4. Attempt an extremely brief summary concerning the subject matter of the objected interrogatories and accompanying document requests you served,
5. Offer your version of the reason for the cancellation petition which began these proceedings and list service uses which do legally and lawfully belong to me in connection with registration # 4106459 for the mark LEGENDARY,
6. Reference a telephone conference you and I engaged in,
7. Make several other demands for my compliance.

I humbly respond with the following:

1. Although you are clearly unhappy with the objection I asserted, I am in compliance with the remedies available to all parties who may be the recipient of excessive interrogatories in accordance with TBMP 405.03(e) which specifically quotes in relation to my objection that;

If a party on which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories exceeds the limit specified in 37 CFR § 2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. [Note 1.] A party should not answer what it considers to be the first 75 interrogatories and object to the rest as excessive.

(underline and bold added for specific emphasis)

In accordance with TBMP 405.03 (e) and 37 CFR § 2.120(d)(1), I refuse to withdraw or alter my objection.

2. The interrogatories and document requests that you sent were inter-related throughout. They were served at the same time, contained a single certificate of service that applied to both, and contained several requests and statements that directly referenced the other. Aside from the several statements in one document that instructed me to refer to the other, the preface of your request for documents directly conveyed the relevance of it to be contingent on the validity of the interrogatories that accompanied it by advising that I refer to "Legend Pictures' First Set of Interrogatories to Davis" for definitions and instructions (a document which happened to be objected in its entirety).

3. You referenced Trademark Rule 2.120(d)(1) and TBMP 405.03(d) and claimed that the discovery requests you served were in complete compliance with them.

You did list a **very small portion of TBMP 405.03(d)** and although the words contained in excerpt of text you listed were accurate, the context in which you are asserting said excerpt is either intentionally or mistakenly misconstrued. The portion of text you quoted from TBMP 405.03(d) was;

... if an interrogatory requests **"all relevant facts and circumstances"** concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory.

Do note that the words... "all relevant facts and circumstances"... are in quotation which directly conveys that interrogatories containing only a phrase of this nature in relation to a particular piece of information shall be counted as a single interrogatory.

I find it extremely peculiar (especially given your experience and employment history with the USPTO) that although TBMP 405.03(d) contains seven paragraphs in the form of 8 notes, you chose to list only the latter half of, and contort the context of a single paragraph - paragraph 6 which is also Note 7. Surely if you had even considered just that single paragraph in its entirety (Note 7), you would have clearly understood that **the interrogatories you served were FAR from reasonably and acceptably compliant with TBMP 405.03(d).**

Allow me to inform you of the full section of TBMP 405.03(d) [Note 7] in proper context as follows;

If an interrogatory requests information concerning more than one issue, such as information concerning both “sales and advertising figures,” or both “adoption and use,” the Board will count each issue on which information is sought as a separate interrogatory. In contrast, if an interrogatory requests “all relevant facts and circumstances” concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory. [Note 7.]

(underline and bold added for specific emphasis)

I remind you of your interrogatories 1 and 2 (a representative sample among a document filled with numerous instances of the like) as examples of noncompliance with this and almost every other note listed in TBMP 405.03(d);

In accordance with TBMP 405.03(d) Notes 1 through 8, the following interrogatories are noncompliant and do exceed their listed count of 1 (one) single interrogatory each.

#### **INTERROGATORY NO. 1**

(1)Identify, with the same degree of particularity as in its registration(s), each of the products or services now or ever applied for, (2)registered,(3) promoted, (4)sold, (5)rendered or (6)performed by DAVIS (see Definitions and Instructions) in connection with any mark consisting of or including the term LEGENDARY (see Definitions and Instructions).

#### **INTERROGATORY NO. 2**

For each and every product or service identified in response to Interrogatory No 1, state the following:

(7)(a) the date DAVIS first either offered, (8)sold or (9)promoted the product or service in connection with the DAVIS LEGENDARY Mark (see Definitions and Instructions) in the United States;

(10)or if the product or service has not yet been offered,(11) sold or (12)distributed, (13)the expected first use date of the DAVIS LEGENDARY Mark in connection with such goods or services;

(14)(b) the earliest priority date DAVIS contends it is entitled to claim as to the United States for each product or service; and

(15)(d) the circumstance (i.e., in the case of actual use, the mark used, or in the case of constructive use, the application filing, by country and serial number) giving rise to such alleged actual or constructive priority rights.

(For any confusion involving re-count #s 7, 14, and 15, please see specifically TBMP 405.03(d) Notes 1 and 2 concerning subparts. For any confusion involving re-count # 10, please see

specifically TBMP 405.03(d) Notes 3, 4, and 5 concerning two or more questions combined in a single compound interrogatory and follow-up questions. For any confusion involving all other re-count #s, please see TBMP 405.03(d) in its entirety [most relevantly Notes 6 and 7])

4. You offered a brief generalization of the content contained in your interrogatories and expressed that the topics of the interrogatories are permitted in accordance with TBMP 402.01. In response to this I remind you that the interrogatories were not objected to on the basis of subject matter, rather excessive length.

5. In your correspondence, you mentioned your client's petition to cancel my registration stating that it was supposedly petitioned on the grounds of willful and knowing misrepresentation of use.

Do allow me to remind you that **YOUR CLIENT EXPRESSED ABSOLUTELY NO OPPOSITION TO MY REGISTRATION UNTIL THEIR NEW APPLICATIONS WERE SUSPENDED IN CITATION AGAINST MY ESTABLISHED REGISTRATION.** Your client's reactive behavior is in direct congruence with **estoppel by laches.** While I understand that it is your job to make me appear to be a liar, this circumstance will not alter the fact that I **did not** commit fraud before the United States Patent and Trademark Office.

6. You mentioned a telephone conference we engaged in on April 10, 2013 and while the portions of the conversation you mentioned were generally accurate you failed to mention some very relevant things that were said in that conversation. I recall you telling me that to that I was required to put my issues or concerns (your direct word was "everything") in writing. As per your instructions, I filed my grievances concerning the excessive length and improper calculations of the petition you served.

In your correspondence you mentioned what you referred to as my "alleged pro se status". As I receive a current income of less than 12,000 annually, I have been unable to afford legal counsel or assistance during this entire proceeding and have been my own personal representation. Although I am self-represented and have no formal legal education, I do hope that these circumstances will not cause you to render any less reverence to my involvement in this proceeding.

I do understand that the nature of your employment for the Petitioner involves creating an undesirable image of me (however untrue that image may be) but I do feel that we can be as amicable as our interactions will allow. With that being said, I am willing to respond to a properly revised set of interrogatories and document requests. To all other demands, I decline. If you disagree with this, I implore you to pursue all remedies you feel may be available to you, as I will do the same.

Nothing contained in this letter is intended, nor shall anything be construed to constitute an express or implied waiver of any rights or remedies to which I the Registrant (Quentin Davis) may be entitled at law or in equity. The foregoing is not intended to be a complete recitation of the facts upon which this matter is based.

With the Utmost Regard,

/Quentin Davis/  
Quentin Davis – Registrant  
P.O. Box 47893  
Tampa Fl. 33646

5/1/2013

Date

**CERTIFICATE OF SERVICE**

I hereby certify that on this 1st day of May 2013, a true and complete copy of the foregoing **REGISTRANT'S INITIAL CORRESPONDENCE TO RESOLVE DISCOVERY DISPUTE** was served to Petitioner via electronic mail to:

Carla Calcagno at e-mail addresses:

**carla.calcagno@calcagnolaw.com**

and

**cccacagno@gmail.com**

Calcagno Law  
2300 M Street, N.W., Suite 800  
Washington, D.C. 20037

/Gloria Walters/

Gloria Walters

Administrative Assistant to the Registrant

P.O. Box 47893

Tampa, Florida 33646

## **REGISTRANT'S SECOND RESPONSE TO RESOLVE DISCOVERY DISPUTE**

Ms. Calcagno,

I have received your May 2<sup>nd</sup> correspondence and with all respect due to your experience concerning matters of legal relevance, I do respectfully disagree with your misconstrued interpretation of TBMP 405.03(d) and your revised count of the interrogatories you served.

While you did admit that your initial interrogatories were improperly calculated (by way of a revised count of your first and second set of interrogatories which by your admission increased their number from 21 to at least 61), your calculations are still insufficient.

I as examples of the calculation discrepancy, I remind you of the count I displayed for your interrogatories 1 and 2:

### **INTERROGATORY NO. 1**

(1)Identify, with the same degree of particularity as in its registration(s), each of the products or services now or ever applied for, (2)registered,(3) promoted, (4)sold, (5)rendered or (6)performed by DAVIS (see Definitions and Instructions) in connection with any mark consisting of or including the term LEGENDARY (see Definitions and Instructions).

### **INTERROGATORY NO. 2**

For each and every product or service identified in response to Interrogatory No 1, state the following:

- (7)(a) the date DAVIS first either offered, (8)sold or (9)promoted the product or service in connection with the DAVIS LEGENDARY Mark (see Definitions and Instructions) in the United States;
- (10)or if the product or service has not yet been offered,(11) sold or (12)distributed, (13)the expected first use date of the DAVIS LEGENDARY Mark in connection with such goods or services;
- (14)(b) the earliest priority date DAVIS contends it is entitled to claim as to the United States for each product or service; and
- (15)(d) the circumstance (i.e., in the case of actual use, the mark used, or in the case of constructive use, the application filing, by country and serial number) giving rise to such alleged actual or constructive priority rights.

In your re-count, you aver that your "Interrogatory No. 1" is a single interrogatory although you ask for 6 completely different things. You ask me to identify products or services I;

1. Applied for... 2. Registered... 3. Promoted... 4. Sold... 5. Rendered, or... 6. Performed.



I implore you to comprehend TBMP 405.03(d) [Notes 3 & 4]

**if a propounding party sets forth its interrogatories as 75 or fewer separately designated questions (counting both separately designated interrogatories and separately designated subparts), but the interrogatories actually contain more than 75 questions, the Board will not be bound by the propounding party's numbering or designating system. Rather, the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory.** [Note 3.] For example, **if two or more questions are combined in a single compound interrogatory, and are not set out as separate subparts, the Board will look to the substance of the interrogatory, and count each of the combined questions as a separate interrogatory.** [Note 4.]

(underline and bold added for specific emphasis)

Suppose I **applied for** services that were never **performed** or **promoted** services that were never **sold**. Perhaps you intended me to respond to a single question in your “Interrogatory No. 1” and allow you to assume that the answer given should apply to all questions listed. There is no affirmative way to answer this interrogatory without multiple answers –which is the reason why the TTAB classifies each of these as separate interrogatories.

You also averred that your “Interrogatory No. 2” subsection (a) is a single interrogatory, yet you ask for 3 different things. You ask me to state the date I first;

1. Offered... 2. Sold, or...3 Promoted... services in connection with my trademark.

I implore you to comprehend TBMP 405.03(d) [Note 6]

if an interrogatory begins with a broad introductory clause (“Describe fully the facts and circumstances surrounding applicant's first use of the mark XYZ, including:”) **followed by several subparts** (“Applicant's **(1)date of first use** of the mark on the goods listed in the application,” “Applicant's **(2)date of first use** of the mark on such goods in commerce,” etc.), the **Board will count the broad introductory clause and each subpart as a separate interrogatory, whether or not the subparts are separately designated.** [Note 6.]

(underline, bold, parenthesis (1) and (2) added for specific emphasis.)

While your “Interrogatory No. 2” does have certain subparts designated individually, they are still insufficiently numbered. Suppose that the dates that I first **promoted** or **offered** or **sold** services in connection with my mark are not the same. There is no affirmative way to answer this interrogatory with a single answer—which is yet another example of the reason why the TTAB classifies each of these as separate interrogatories.

The two interrogatories listed in this correspondence are merely representative samples of your first and second set of interrogatories which are filled with numerous similar instances.

You averred in your second correspondence that you are permitted to ask as many portions of information that you feel to be relevant facts and circumstances concerning an issue as a single interrogatory. TBMP 405.03(d) [Note 7] **SPECIFICALLY QUOTES:**

If an interrogatory requests information concerning more than one issue, such as information concerning both “**sales and advertising figures,**” or both “**adoption and use,**” **the Board will count each issue on which information is sought as a separate interrogatory.**

(underline and bold added for specific emphasis)

Sales and advertising figures as well as adoption and use are all information requests that may be deemed relevant concerning a single issue yet **the Board still counts each as a separate interrogatory.** It is extremely difficult to misconstrue the clarity of this guideline, yet your logic concerning counting of interrogatories would deem an interrogatory containing all of these requests as a single interrogatory.

While it is at this point quite noticeable that even in your secondary correspondence concerning this issue, you are still attempting to assert a very small and contextually inaccurate portion of TBMP 405.03(d) which you feel will best support your invalid claims, you have not explained why you are completely refusing to address any other portion of TBMP 405.03(d) which very clearly and directly contradicts your initial and secondary calculations of the interrogatories you served.

Ms. Calcagno I am not looking for a fight. I only request fair process and consideration in these proceedings. In the interest of civility, I am willing to respond to the portions of document requests you served which are unconnected to the interrogatories. I am willing to serve answers to these specific document requests before the close of discovery. However, as you have still offered no explanation whatsoever for your extremely extensive, sixteen-day delay in responding to the objections I served, I am unwilling to agree to discovery extension.

(Please note that your second correspondence requests that I comply with days that do not exist. i.e. "Friday, May 5, 2013" and "Monday May 8, 2013")

Nothing contained in this letter is intended, nor shall anything be construed to constitute an express or implied waiver of any rights or remedies to which I the Registrant (Quentin Davis) may be entitled at law or in equity. The foregoing is not intended to be a complete recitation of the facts upon which this matter is based.

With the Utmost Regard,

/Quentin Davis/  
Quentin Davis – Registrant  
P.O. Box 47893  
Tampa Fl. 33646

5/3/2013

Date

**CERTIFICATE OF SERVICE**

I hereby certify that on this 3rd day of May 2013, a true and complete copy of the foregoing **REGISTRANT'S SECOND RESPONSE TO RESOLVE DISCOVERY DISPUTE** was served to Petitioner via electronic mail to:

Carla Calcagno at e-mail addresses:

**carla.calcagno@calcagnolaw.com**

and

**cccalcagno@gmail.com**

Calcagno Law  
2300 M Street, N.W., Suite 800  
Washington, D.C. 20037

/Gloria Walters/

Gloria Walters

Administrative Assistant to the Registrant

P.O. Box 47893

Tampa, Florida 33646

## EXHIBIT H

THIS OPINION  
IS NOT A PRECEDENT  
OF THE T.T.A.B.

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

DUNN

Mailed: September 18, 2008

Opposition No. 91177903

Columbia Insurance Company

v.

Eric J. Delfyette

Before Hohein, Rogers, and Cataldo, Administrative Trademark  
Judges:



By the Board:

This case comes up on applicant's motion, filed March 12, 2008, for summary judgment on the claims of likelihood of confusion and dilution, or, in the alternative, to compel responses to interrogatories, and opposer's cross-motion for summary judgment on the claim of likelihood of confusion. Both motions have been briefed.

In the notice of opposition filed June 19, 2007, opposer pleads likelihood of confusion with, and dilution of, the marks shown below, which are the subjects of its pleaded registrations for footwear, and applicant's mark, also shown below, which is the subject of its Application

Opposition No. 91177903

Serial No. 78903777 for clothing and footwear, filed on the basis of applicant's allegation of a bona fide intent to use the mark in commerce.

<b>BØRN</b>		
Opposer's Reg. No. 1947333	Opposer's Reg. No. 2691287	App. Ser. No. 78903777

Applicant's answer denies the salient allegations of the notice of opposition.

The record shows that applicant served opposer with its first set of interrogatories and first set of document requests on July 25, 2007. On November 9, 2007, opposer served its response to the document requests, stating that it would produce responsive documents. On January 3, 2008, opposer wrote applicant with its objection that the number of interrogatories exceeded seventy-five. On January 4, 2008, applicant served opposer with a letter which pointed out that opposer had waived its right to object to the interrogatories by failing to respond within thirty days, and disputing the contention that the interrogatories exceeded seventy-five. By stipulation of the parties

Opposition No. 91177903

approved by the Board, discovery was extended and closed March 5, 2008.

#### CROSS-MOTIONS FOR SUMMARY JUDGMENT

In support of its motion for summary judgment on the claims of likelihood of confusion and dilution, applicant submits the documents produced by opposer, refers to the third-party registrations attached to its answer, and argues that notwithstanding applicant's discovery requests, opposer has produced no survey evidence or evidence of fame, sales, or advertising and promotion of opposer's marks.

In opposition to the motion, opposer submits the unverified statement of Anthony Capozza, Director of Corporate Administration for opposer's licensee, H.H. Brown, with attached advertisements and announcements of promotional events for goods bearing opposer's marks. Mr. Capozza states that H.H. Brown markets a variety of footwear using the BORN marks, that such BORN footwear has been sold since 1994 with sales in the millions of dollars, and that H.H. Brown has advertised BORN footwear in mass markets. Opposer also relies upon two additional BORN registrations not pleaded in the notice of opposition to argue that the purchasing public will believe that applicant's goods sold under the BORN-OFFICIAL mark originate with opposer.



Opposition No. 91177903

exist but that opposer objects to producing it to applicant. With respect to opposer's motion, the statement by Anthony Capozza begins "Anthony Capozza, being duly sworn in and based on his personal knowledge states as follows..." The vague reference to "being sworn" does not meet the requirements for a declaration in lieu of affidavit under Trademark Rule 2.20.

In short, with the exception of opposer's ownership of two pleaded registrations, copies of which were filed with notice of opposition, the parties have not established that any material facts are undisputed. The cross-motions for summary judgment are denied.

APPLICANT'S MOTION TO COMPEL

Turning to applicant's alternative motion to compel responses to its interrogatories, we agree that by waiting until January 3, 2008 to object to interrogatories served July 25, 2007, opposer has waived its right to object. Moreover, even if opposer had timely objected to the number of interrogatories as excessive, the objection that the interrogatories comprise 379 subparts would be unfounded.

Applicant's interrogatories comprise twenty four separate interrogatories, more than half of which have no subparts and comprise single issues. In this regard, while this is not the sole basis for what we consider gross over-

Opposition No. 91177903

counting, we note that opposer impermissibly multiplies each interrogatory by the three marks pleaded in the notice of opposition. Where, as here, multiple marks are involved in a proceeding, for purposes of counting interrogatories, "the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark." Trademark Trial and Appeal Board Manual of Procedure (TBMP) 405.03(c) (2nd ed. rev. 2004).

Accordingly, applicant's motion to compel opposer's responses to its first set of interrogatives is granted. Opposer is allowed until twenty days from the mailing date of this order to provide its responses, without objection, failing which a motion for sanctions will be entertained by the Board. See Trademark Rule 2.120(g)(1).

Because there has been no prior Board order on discovery matters, to the extent that applicant's motion to compel also argues for sanctions, the motion is denied.<sup>2</sup> Trademark Rule 2.120(g)(1).

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<sup>2</sup> Applicant also is advised that the Board will not award fees. See Trademark Rule 2.120(g)(1).

DISCOVERY PERIOD TO CLOSE:

CLOSED

Thirty-day testimony period for party in position of plaintiff to close:	December 15, 2008
Thirty-day testimony period for party in position of defendant to close:	February 13, 2009
Fifteen-day rebuttal testimony period to close:	March 30, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbamp/stndagmnt.htm>

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

COPY

COLUMBIA INSURANCE COMPANY

Opposer,

vs.

ERIC J. DELFYETTE,

Applicant.

IN THE MATTER OF:

Opposition No. 91177903

**APPLICANT'S FIRST SET OF INTERROGATORIES TO OPPOSER**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, 37 C.F.R. § 2.120, and the Trademark Rules of Practice, Applicant Eric J. Delfyette ("Applicant"), by counsel, hereby requests that Opposer Columbia Insurance Company, ("CIC" or "Opposer") answer fully under oath the following interrogatories within thirty (30) days after service thereof. These answers are to be sent to Erik M. Pelton & Associates, PLLC, PO Box 100637, Arlington, Virginia 22210.

**DEFINITIONS**

The following definitions apply to and are deemed incorporated into each question in this first set of interrogatories:

1. "Columbia Insurance Company," "Columbia Insurance," "CIC," "you," "your," or "Opposer" means Opposer Columbia Insurance Company, its officers, directors, employees, counsel, agents, representatives, or other persons under its control, any predecessor or successor whether incorporated or not, any division, subsidiary or affiliate thereof, and those persons in active concert or participation with it or them.

2. "Document" shall refer to all items within the scope of Rule 34, Federal Rules of Civil Procedure.

3. "Person" or "persons" shall refer to any individual, corporation, proprietorship, partnership, association, joint venture, business trust, receiver, estate syndicate government agency or other entity, including the parties to this suit and their officers, agents, employees and representatives.

4. The "BØRN Marks" include the mark in U.S. Trademark Application Serial Numbers 74471830 and 75727066, all marks of Opposer incorporating the terms BØRN or BORN, and all variations thereof including, but not limited to variations in which not all of the letters are capitalized, variations in which they are combined with a superscript such as "TM," "SM," "Tm," "Sm," "tm," "sm" or "@" or any other variation intended to convey that they, BØRN and BORN WAVZ & Design, are trademarks.

5. The term "mark" or "marks" includes any trademark, service mark, trade name, collective mark or certification mark, as defined by 15 U.S.C. § 1127, and any other phrase or symbol used as a source identifier for a particular good or service.

6. The words "and" and "or" are construed both conjunctively and disjunctively, and each includes the other wherever such dual construction will serve to bring within the scope of this request any documents which would otherwise not be brought within its scope. All such terms, as well as other conjunctions and prepositions, are interpreted in the manner that provides the most complete answer and information.

7. "Each" means each and every.

8. "Communication" means all discussions, conversations, interviews, negotiations, cable grams, mail grams, e-mails, telegrams, telexes, facsimile transmissions, cables, letters, confirmations, or other forms of written or verbal discourse, however transmitted, including reports, notes, electronic files and databases, memoranda, lists, agents and other documents and

## **INTERROGATORIES**

### **Interrogatory No. 1**

Identify, as described in Instruction No. 3, the Opposer, Columbia Insurance Company.

**ANSWER:**

### **Interrogatory No. 2**

Identify and describe with specificity each good and service in connection with which each of the BØRN Marks, or any variation thereof, has been used or is currently being used by Opposer, or any authorized user of the marks.

**ANSWER:**

### **Interrogatory No. 3**

With respect to each of the goods and services identified in response to Interrogatory No. 2, describe all relevant facts and circumstances regarding the first use of the BØRN marks in interstate commerce in the United States.

**ANSWER:**

### **Interrogatory No. 4**

- (a) With respect to each of the goods and services identified in response to Interrogatory No. 2, state the annual sales in dollars for each year from 2000 to the present.
- (b) Identify the persons with the most complete knowledge of the information given

in answer to subpart (a) herein.

**ANSWER:**

**Interrogatory No. 5**

- (a) With respect to each of the goods and services identified in response to Interrogatory No. 2, describe all relevant facts and circumstances regarding the manner in which each of the **BØRN Marks** are promoted in the United States.
- (b) For each instance of promotion of each of the **BØRN Marks** described in subpart (a) herein, specify the annual expenditure for promotion during each of the years 2000 to the present.
- (c) For each instance of promotion of each of the **BØRN Marks** described in subpart (a) herein, identify the persons with the most complete knowledge thereof.

**ANSWER:**

**Interrogatory No. 6**

With respect to each of the goods and services identified in response to Interrogatory No. 2, describe all relevant facts and circumstances regarding the channels of trade by which the goods or services of the Opposer reach the ultimate end customer.

**ANSWER:**

**Interrogatory No. 7**

- (a) Describe in detail any trademark search conducted in connection with each of the

**BØRN Marks.**

- (b) Describe in detail any **trademark search** conducted in connection with any challenge a third party has made to the **BØRN Marks**.
- (c) **Identify all documents** related to any search described in subparts (a) or (b) herein.

**ANSWER:**

**Interrogatory No. 8**

- (a) **Identify any authorized user** of the **BØRN Marks**.
- (b) Describe all relevant facts and circumstances regarding instances where Opposer has **authorized use of the BØRN Marks to an authorized user.**

**ANSWER:**

**Interrogatory No. 9**

Describe all relevant facts and circumstances regarding Opposer's first knowledge of Applicant's **BORN=OFFICIAL & Design mark**.

**ANSWER:**

**Interrogatory No. 10**

**Identify all documents** in Opposer's possession which refer or relate to Applicant or to use of the **BORN=OFFICIAL & Design Mark**, or any variations thereof, by Applicant.

**ANSWER:**

**Interrogatory No. 11**



- (a) Describe all relevant facts and circumstances relating to any challenges Opposer has made against any third party concerning a mark allegedly confusingly similar to Opposer's BØRN Marks.
- (b) Describe all relevant facts and circumstances relating to any challenges a third party has made against Opposer concerning the alleged similarity between Opposer's BØRN Marks and the mark of a third party.

**ANSWER:**

**Interrogatory No. 12**

Identify the persons who, from the date of Opposer's first use of the BØRN Marks to the present, have been responsible for the promotion of goods and services under the BØRN Marks, indicating the period during which each person was so responsible.

**ANSWER:**

**Interrogatory No. 13**

Identify each objection made by Opposer to the use by others of any mark believed by Opposer to be confusingly similar to the BØRN Marks, and identify all documents referring or relating to such objections.

**ANSWER:**

**Interrogatory No. 14**

Describe fully any survey conducted to determine whether there exists a likelihood of confusion between the BØRN Marks, and any other marks.

**ANSWER:**

**Interrogatory No. 15**

- (a) Identify all service providers which Opposer has used in promoting the goods and services identified in response to Interrogatory No. 2.
- (b) For each of the service providers named in part (a) herein, state the time periods during which the promotional activities were conducted.

**ANSWER:**

**Interrogatory No. 16**

Describe in detail any plans or steps to expand the number of products or services with which the BØRN Marks, or any related mark is used, to alter the channels of trade mentioned in the answer to Interrogatory No. 2, or to sell such goods and services to purchasers other than those mentioned in the answer to Interrogatory No. 2.

**ANSWER:**

**Interrogatory No. 17**

Describe with specificity the way in which Opposer's goods and services, which are sold under the BØRN Marks, compete with or are similar Applicant's goods and/or services.

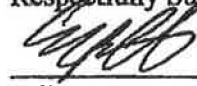
**ANSWER:**

**Interrogatory No. 18**

- (a) Identify the date on which Opposer first became aware of Applicant's use of

Dated: July 25, 2007

Respectfully Submitted,



Erik M. Pelton, Esq.  
Attorney for Applicant

Erik M. Pelton & Associates, PLLC  
PO Box 100637  
Arlington, Virginia 22210  
(703) 525-8009

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the Applicant's First Set of Interrogatories to Opposer was deposited as First Class mail with the United States Postal Service on July 25, 2007, to counsel for Opposer at:

Andy I. Corea  
St. Ogne Steward Johnston & Reens, LLC  
986 Bedford St  
Stamford, CT 06905

By:



Erik M. Pelton, Esq.

## EXHIBIT I

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: August 11, 2006

Opposition No. 91165753

QMT Associates, Inc. QMT  
Associates, Inc.

v.

Sara Neal Eskew

**Frances S. Wolfson, Interlocutory Attorney:**

This case now comes before the Board for consideration of opposer's motion (filed April 27, 2006) to compel applicant to answer opposer's first set of interrogatories and requests for production of documents and to test the sufficiency of applicant's answers to opposer's requests for admissions. The motion has been fully briefed.

**MOTION TO COMPEL RESPONSES TO INTERROGATORIES**

Applicant contends that opposer has propounded more than 75 interrogatories in violation of Trademark Rule 2.120(d)(1). When counting interrogatories, each numbered subpart must be counted separately regardless of whether the division was made for clarification or convenience. Further, compound questions seeking separate information but not set forth separately will be broken down by the Board and counted as separate

Opposition No. 91165753

interrogatories. See TBMP §406.03(d); *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055 (TTAB May 29, 1990); and Calcagno, *Tips From the TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)*, 80 TMR 285 (1990).

Applying the above methodology, the Board finds that the interrogatories do not number in excess of 75. Accordingly, applicant must answer the interrogatories fully and completely.

**MOTION TO COMPEL DOCUMENT PRODUCTION**

Opposer has propounded nine document production requests seeking responsive documents. Applicant objects generally to the requests on the ground that the place and time of production is unknown. Production may be made at the place where the documents and things are usually kept, although the Board encourages applicant to extend to opposer the courtesy of exchanging copies as the parties are geographically distant from one another. See Trademark Rule 2.120(d)(2); and TBMP § 406.03 (2d ed. rev. 2004).

Regarding the specific requests, the Board has reviewed each request and determined that they seek relevant information within the scope of Fed. R. Civ. P. 26(b)(1).

With respect to request No. 1, applicant must produce documents that are identified in its responses to opposer's interrogatories. With respect to request No. 2, applicant must produce documents received from or submitted to the USPTO. With

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respect to Request Nos. 3 and 5, applicant must either affirmatively state that no responsive documents exist, or produce the responsive documents. With respect to Request Nos. 4, 6, 7 and 8, applicant must produce responsive documents; if the number of documents involved is such that it would place an undue burden on applicant, representative samples of requested documents may be provided. See *Bison Corporation v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987). Finally, with respect to Request No. 9, this request assumes that applicant has contended there is a court ruling that "acknowledge[s] that ESKEW's trade dress is legally protectible." If applicant does not believe that such a court ruling exists, it may object to the document production request on that basis. Otherwise, a copy of the ruling must be produced or identified in a manner sufficient to enable opposer to obtain a copy of same (for example, by citation of the decision if published, or by reference to the parties, the jurisdiction, and the proceeding number).

We note that applicant has further objected to request No. 4 on the basis of privilege. To the extent opposer's interrogatories seek identification of privileged documents, opposer cannot refuse to identify them merely because they might be shielded from production by privilege. On the other hand, to the extent that applicant objects to producing certain documents because they may be shielded from production by privilege, a

Opposition No. 91165753

privilege log describing the documents should be made by applicant, so opposer and the Board can assess the applicability of a particular claim of privilege. See, e.g., 8 Wright, Miller & Marcus, Federal Practice and Procedure §2016.1 (2d ed. 1994).

**MOTION TO TEST SUFFICIENCY OF RESPONSES TO ADMISSION REQUESTS**

A motion to test the sufficiency of responses, rather than a motion to compel, is applicable to requests for admission. Fed. R. Civ. P. 36(a) requires that the answering party admit or deny the matter set forth in the requests for admission, or detail the reasons why the party can do neither. See Trademark Rule 2.120(h); and TBMP § 524 (2d ed. rev. 2004).

Here, applicant has denied each of the admission requests at issue herein. Applicant's denials are deemed sufficient. While it appears opposer disputes the veracity of applicant's responses, a motion to test the sufficiency of a response to an admission request is solely a test of the legal sufficiency of that response. Disagreements regarding the veracity of such responses are matters to be determined at trial and are not properly the subject of a motion to test their sufficiency.

Accordingly, opposer's motion to test the sufficiency of applicant's answers to its requests for admissions is denied.<sup>1</sup>

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<sup>1</sup> Notwithstanding, the Board notes that applicant argues it has denied the requests for admissions in part because it construes the word "claims" therein to be a legal term of art. The Board disagrees that such meaning should be applied to the wording. Applicant is instructed to review its answers to each request for admissions



Opposition No. 91165753

In sum, opposer's combined motion is granted in part and denied in part: Opposer's motion to compel applicant's responses to opposer's first set of interrogatories and requests for production of documents is granted. Opposer's motion to test the sufficiency of applicant's answers to the requests for admissions is denied.

Applicant is allowed until THIRTY DAYS from the mailing date of this order to respond fully and completely to opposer's first set of interrogatories, and to produce responsive documents in connection with document production request Nos. 1-9. If applicant believes any matter sought to be discovered constitutes trade secret or confidential information, and the parties cannot agree on the terms for protecting its disclosure, applicant may move for a suitable protective order. See TBMP §§ 416 and 526 (2d ed. rev. 2004).

Trial dates are reset as indicated below. Discovery is closed in this proceeding.

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wherein the word "claims" appears and apply the common dictionary meaning to the word. If revised answers are appropriate, applicant is ordered to provide them.

Opposition No. 91165753

DISCOVERY PERIOD TO CLOSE:

**CLOSED**

30-day testimony period for party in the position of  
plaintiff to close:

**December 1, 2006**

30-day testimony period for party in the position of the  
defendant to close:

**January 30, 2007**

15-day rebuttal period for party in the position of the  
plaintiff to close:

**March 16, 2007**

**IN EACH INSTANCE**, a copy of the transcript of testimony,  
together with copies of documentary exhibits, must be served on  
the adverse party within **thirty days** after completion of the  
taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules  
2.128(a) and (b). An oral hearing will be set only upon request  
filed as provided by Trademark Rule 2.129.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/213,865, filed February 12, 2003  
For the Mark MISCELLANEOUS DESIGN

QMT ASSOCIATES, INC.,	§	
Opposer	§	
	§	
v.	§	Opposition No. 91165753
	§	
SARA NEAL ESKEW,	§	
Applicant	§	

APPLICANT'S RESPONSE TO MOTION TO COMPEL

Applicant, Sara Neal Eskew, hereby responds to Opposer's Motion to Compel, urging the Board to overrule the same.

QMT'S INTERROGATORIES WERE EXCESSIVE IN NUMBER

The Board only allows service of 75 interrogatories, including subparts. TBMP § 405.03(a); 37 CFR § 2.120(d)(1). Eskew has objected to the QMT interrogatories, thus far, solely on this ground.

In a further effort to resolve this matter, Eskew's counsel sent an email to opposing counsel before the motion to compel was filed on April 27, 2006. A printout of the email is attached hereto as Exhibit 1. The communication clearly explains that when this ground is raised, Eskew understands that the Board has instructed no other objections or answers

are to be made.

The main interrogatory of contention is no. 8, in which QMT asks Eskew to (1) state all facts and (2) identify all documents upon which Eskew relies to deny each request for admissions "below" that are not categorically admitted.

Furthermore, QMT request for admission no. 19 refers to an additional set of 39 earlier responses to requests for admission, also attached as an exhibit "below" interrogatory no. 8, only 2 of which were categorically admitted in the earlier action, for a grand total of 56 actual or 58 potential "Eskew's responses to QMT's requests for admissions below" that "are anything other than a categorical admission."

Clearly, QMT has attempted to circumvent the limit on interrogatories by essentially converting each of 56 requests for admission into two interrogatories for a total of 112 subparts in interrogatory no. 8 alone (as well as converting each into a document request under QMT's production request number 1).

Serving an interrogatory that requests disclosure of all of the reasons on which the denials of each of 56 requests for admissions were based essentially transforms each request for admission into an overbroad,

multipart interrogatory. In other words, QMT has in effect served not 1 interrogatory in no. 8, but 112.

Strictly speaking, the request for admissions procedure of Fed. R. Civ. P. 36 is not a discovery procedure at all, since it presupposes that the party proceeding under it knows the facts or has the document and merely wishes its opponent to concede their genuineness. A party who desires to discover what the facts are should resort to discovery rules other than Rule 36. *Safeco of America v. Rawstron*, 181 F.R.D. 441, 445-446 (C.D. Cal 1998) (citing 8A C. WRIGHT, A. MILLER & R. MARCUS, Federal Practice and Procedure §2253 (2d ed. 1994)). Requests for admissions are not intended as a general discovery device, as QMT has attempted to do in this case. This is not the purpose requests for admission were intended to serve, and condoning such a practice would circumvent the numerical limit of 75 placed on interrogatories by the Board and the Rule 2.120(d)(1). See *Safeco*, 181 F.R.D. at 445-6 (citing cases).

Even if QMT interrogatory no. 8 is only counted as 56, the other interrogatories easily exceed the remaining allotment of 19. The parts and subparts easily exceed 75 according to Eskew's count as follows:

<u>Interrogatory</u>	<u>Subparts</u>
1	witness + testimony = >2
2	expert witness + a-h = >9
3	(functionality + distinctiveness)(facts + surveys) = >4
4	Legal proceedings + a-g = >6
5	Current + past third party uses = >2
6	Design features = >1
7	Statement of court + QMT = >2
SUBTOTAL	= >26
8	(facts + documents)X(56 'denied' admissions) = 112
TOTAL	= >138

The Board specifically allows a party responding to interrogatories to interpose the objection of excessive number, without waiving objections to specific interrogatories on other grounds. TBMP § 405.03(e). The motion to compel the interrogatory answers can justifiably be denied in its entirety under the present circumstances. However, since the deadline for discovery has long since passed (the excessive interrogatories were served on the last day of the discovery period), should the Board permit an

amended set of interrogatories, the revised set should not exceed the information sought in the excessive set. *Id.*

#### QMT'S REQUESTS FOR ADMISSION WERE FAIRLY DENIED

Requests for admission nos. 1-14 extracted isolated language from Eskew's website and asked for an admission that the parsed language amounted to a "claim." Eskew properly denied that the language amounted to a "claim," which Eskew took as a term of art with legal implications beyond the mere appearance of the language on one of the website pages. Moreover, the selected passages are taken out of context and amount to a parsing of individual elements abstracted for attempted proof of functionality, whereas Eskew understandably declines to admit the irrelevant issue of de facto functionality of isolated individual product features. Furthermore, the requested admissions would circumvent the evidentiary rule of completeness, Fed. R. Evid. 106. These requests were fairly denied by Eskew.

Request for admission no. 15 was admitted in part factually and to a fair extent; issues fairly in dispute were fairly denied.

The pages from the website asked to be authenticated in request for admission no. 16 were not accurate in that they similarly evade the

## EXHIBIT J



**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Mailed: April 6, 2012

**Opposition No. 91195911  
(parent case)**  
Opposition No. 91198725

South Cone, Inc.

v.

Swimwear Anywhere, Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of:

1) opposer's motion (filed November 23, 2011) to compel responses to document requests and interrogatories, and to extend discovery; 2) applicant's motion (filed November 28, 2011) to compel, to suspend and to extend; and 3) opposer's motion (filed January 20, 2012) to strike applicant's reply in further support of its motion.

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (3d ed. 2011). On April 4, 2012, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were opposer's

In its reply, opposer did not narrow or delineate the requests with respect to which it maintains that applicant's productions were deficient, as the Board would expect opposer to have done inasmuch as the reply was filed after applicant's two document productions. See TBMP § 523.02 (3d ed. 2011). Consequently, the Board has been burdened with resolving this matter on a record that does not clearly indicate whether applicant's production is or is not responsive.

In view thereof, and in view of applicant's assertion that it presently does not have responsive documents further to those which it has already produced, opposer's motion on this point is denied.

**Applicant's motion to compel, to suspend and to extend**

**Interrogatories**

In lieu of serving responses, opposer served a general objection on the ground that applicant's interrogatories, including subparts, exceed seventy-five. See Trademark Rule 2.120(d)(1). In various correspondences, the parties failed to resolve this issue.

Applicant's interrogatories do not exceed seventy-five. Opposer's proposed counting methodology, calling for multiplication of certain interrogatories by the number of goods and services in the application or registration, and concluding that each good and service should be treated as a separate "issue" for purposes of counting subparts, is

Opposition No. 91195911

incorrect and inconsistent with the purpose and scope of discovery. Additionally, opposer's arguments that the requirement to respond with the date of first use of each of its goods poses an "excessive burden" and raises the issue of relevance is unpersuasive, particularly given that opposer brought this proceeding asserting grounds on which opposer has the burden of proving its own priority of use.

In view of these findings, applicant's motion is granted. Opposer is allowed until thirty (30) days from the conference date in which to serve responses to applicant's first set of interrogatories 1-23.

Opposer posits that applicant's "Definitions and Instructions" includes applicant's marks within applicant's definition of "the South Cone Reef Marks" and thus is "confusing and improper." Opposer is correct that paragraph h of applicant's "Definitions and Instructions" includes "or Swimwear Anywhere."

During the conference, counsel for applicant stated that the inclusion of "or Swimwear Anywhere" in said definition was a typographical error, and agreed that said matter is hereby stricken from paragraph h, its definition of "the South Cone Reef Marks."

In view of the now corrected definition, opposer's objection on this point is moot.

Document requests

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

South Cone, Inc.	)	
	)	
Opposer	)	
	)	
	)	
v.	)	<b>Opposition Nos. 91195911 and 91198725</b>
	)	
	)	
Swimwear Anywhere	)	
	)	
Applicant	)	

**SWIMWEAR ANYWHERE’S FIRST SET OF INTERROGATORIES 1-23**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Swimwear Anywhere, Inc. (Swimwear Anywhere) requests that South Cone, Inc. (South Cone) serve upon Swimwear Anywhere sworn answers to the interrogatories set forth below at the offices of Calcagno Law, 2300 M Street, N.W., Suite 800, Washington, D.C. 20037, within thirty (30) days after the service hereof. These discovery requests are intended to be continuing in nature and any information or materials which may be discovered subsequent to the service and filing of the answers should be brought to the attention of Swimwear Anywhere through supplemental answers within a reasonable time following such discovery.

For the convenience of the Board and the Parties, Swimwear Anywhere requests that each discovery request (including subparts) be quoted in full immediately preceding the response.

## **DEFINITIONS AND INSTRUCTIONS**

a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships and corporations.

b. The term "Applicant," "or "Swimwear Anywhere", shall mean Swimwear Anywhere, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of any mark or designation consisting of or including the term REEF and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.

c. The term "Opposer," "South Cone" or "South Cone, Inc.", shall mean South Cone, Inc., its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of any mark or designation consisting of or including the term REEF, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.

d. In the following discovery requests, the term "document" or "documents" is used in its customary broad sense to mean all non-identical copies of all documents within the scope of Rule 34, Fed. R. Civ. P., including, without limitation, reports and/or summaries of interviews; reports and/or summaries of investigations; opinions or reports of consultants; opinions of counsel; communications of any nature including internal company communications; memoranda; notes; letters; e-mail; agreements; reports or summaries of negotiations; brochures; pamphlets; advertisements; circulars; trade letters; press releases; drafts of documents and revisions of drafts of documents and any written, printed, typed or other graphic matter of any kind of nature; drawings; photographs; charts; electronically stored data; and all mechanical and electronic sound recordings or transcripts thereof, in the possession and/or control of South Cone

or its employees or agents, or known to South Cone to exist, and shall include all non-identical copies of documents by whatever means made and whether or not claimed to be privileged or otherwise excludable from discovery. By way of illustration only and not by way of limitation, any document bearing on any sheet or side thereof any marks, including, but not limited to, initials, stamped indicia, comment or notation of any character and not a part of the original text or any reproduction thereof, is to be considered a separate document, in the case of a machine readable document, identify the specifications and/or common name of the machine on which the document can be read such as "VHS videotape, MS DOS (IBM) PC using WordPerfect 5.1" or the like.

e. In the following discovery requests, where identifications of a document is required, such identification should describe the document sufficiently so that it can be specifically requested under Rule 34, Fed. R. Civ. P., and should include without limitation the following information, namely:

- I. the name and address of the author;
- ii. the date;
- iii. the general nature of the document, i.e., whether it is a letter, memorandum, pamphlet, report, advertising (including proofs), etc.;
- iv. the general subject matter of the documents;
- v. the name and address of all recipients of copies of the documents;
- vi. the name and address of the person now having possession of the original and the location of the original;
- vii. the name and address of each person now having possession of a copy and the location of each such copy;

viii. for each document South Cone contends is privileged or otherwise excludable from discovery, the basis for such claim of privilege or other grounds for exclusion; and

ix. whether South Cone is willing to produce such document voluntarily to Swimwear Anywhere for inspection and copying.

f. In the following discovery requests, where identification of a person, as defined, is required, state:

I. the person's full name, state of incorporation, if any, present and/or last known home address (designating which), present and/or last known position or business affiliation (designating which), and/or present or last known affiliation with South Cone (designating which), if any. In the case of a present or past employee, officer or director or agent of South Cone, also state the person's period of employment or affiliation with South Cone, and his or her present or last position during his affiliation with South Cone.

g. In the following discovery requests, where identification of an oral communication is required, state the date, the communicator, the recipient of the communication, and the nature of the communication.

h. All references in these discovery requests to "the South Cone Reef Marks" shall mean all marks and designations consisting of or including the term REEF and all variations thereof, used, applied for, or registered by or on behalf of South Cone or Swimwear Anywhere, as the case may be, (see Definitions above) whether printed in all capital letters, all lower case letters, or a mixture of capital with lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, letters, numbers, symbols, or designs, upon

which South Cone may rely in these proceedings. This definition specifically includes but is not limited to each of the marks plead by South Cone in these proceedings.

i. All references in these discovery requests to the "Swimwear Anywhere's Marks" shall mean all marks and designations consisting of or including the term REEF whether printed in all capital letters, all lower case letters, or a mixture of capital with lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, letters, numbers, symbols, or designs which South Cone has opposed in these proceedings or which Swimwear Anywhere has pleaded in its Counterclaim for Cancellation.

j. All references in these discovery requests to "the Parties Marks" shall mean all marks and designations consisting of or including the term REEF and all variations thereof, used, applied for, or registered by or on behalf of Swimwear Anywhere, (see Definitions above) or the South Cone Reef marks ( see Definitions above), whether printed in all capital letters, all lower case letters, or a mixture of capital with lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, letters, numbers, symbols, or designs. This definition specifically includes but is not limited to each of the marks pleaded by South Cone and Swimwear Anywhere and those opposed by South Cone in these proceedings.

k. Whenever used herein, the term "&" shall be deemed to include the term "and" and the term "n"; the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include the disjunctive ("or"); and each of the functional words "each," "any," and "all" shall be deemed to include each of the other functional words.



m. The terms "state" or "describe" (as used with respect to specific interrogatories below) shall mean to set forth and/or identify with particularity all evidence or other information available to South Cone (see Definition a. above) concerning the matter, to identify each person with knowledge and to identify all communications and documents concerning the subject matter.

## **INTERROGATORIES**

### **INTERROGATORY NO. 1**

Identify with the exact same degree of particularity as in South Cone's pleaded registrations each of the products or services now or ever applied for, registered, promoted, sold, rendered by South Cone (see Definitions and Instructions) in connection with any marks upon which South Cone may rely in these proceedings (hereinafter the South Cone Reef marks).

### **INTERROGATORY NO. 2**

For each and every product or service identified in response to Interrogatory No 1, state the following:

(a) the date South Cone first either offered, sold or promoted the product or service in connection with each of the South Cone Reef Marks in the United States; or if the product or service has not yet been offered, sold or distributed, the expected first use date of the South Cone Reef Marks in connection with such goods or services;

(b) the earliest priority date South Cone contends it is entitled to claim as to the United States for each product or service; and

(d) the circumstance (i.e., in the case of actual use, the mark used, or in the case of constructive use, the application filing, by country and serial number) giving rise to such alleged actual or constructive priority rights.

### **INTERROGATORY NO. 3**

Identify all outside firms that are now or have ever been employed by South Cone (see definitions and instructions) in connection with the advertising of the South Cone Reef Marks in the United States, and state the identity of those persons responsible for South Cone's account with respect to the South Cone Reef Marks. This specifically includes but is not limited to the agencies or firms now or ever employed by South Cone in connection with the design, text or content of each webpage ever displayed by South Cone for products or services advertised or offered under the South Cone Reef Marks.

### **INTERROGATORY NO. 4**

For each and every product or service identified in response to Interrogatory No. 1 now or ever sold by South Cone under South Cone's Reef Marks in the United States, state the inclusive dates during which South Cone has offered or sold such goods under South Cone's Reef Marks in the United States, and for any periods of non-use in the United States, explain the reasons for such non-use.

### **INTERROGATORY NO. 5**

Identify all instances of actual confusion, mistake or deception known to South Cone as to the source or origin, sponsorship or association as between its use or proposed use of any mark or designation consisting of or including the South Cone Reef Marks for any goods or services and Swimwear Anywhere's Marks ( see Definitions and Instructions).

**INTERROGATORY NO. 6**

Identify each person whom South Cone expects to call as a witness at trial, state the subject matter on which the person is expected to testify, and state the substance of the facts and opinions to which the person is expected to testify and a summary of the grounds for each opinion.

**INTERROGATORY NO. 7**

Identify each person (see Definitions and Instructions) South Cone is aware of who now or ever has used, applied for, or registered any mark, company or trade name, or domain name (hereafter collectively “proprietary designations” consisting of, or including, the term REEF for any goods or services in the United States and state the nature of the goods or services on which each of these proprietary designations were used, applied for, or registered by each third party; whether South Cone objected to such use or application or registration, and whether such objection resulted in the termination of such use or application or registration.

**INTERROGATORY NO. 8**

For each product and service presently distributed, offered, sold or promoted or planned to be distributed, offered, sold or promoted under South Cone’s Reef Marks in the United States, state the channels of trade through which South Cone moves and/or intends will move such products and/or services.

**INTERROGATORY NO. 9**

State the name of the parties, and the civil action, opposition or other proceeding number and the jurisdiction of all legal or administrative or regulatory proceedings known to South Cone

brought by or against South Cone or any affiliated company involving any of the goods or services pleaded or opposed by either party in these proceedings or which concern any mark or designation consisting of the term REEF, or allegations of trademark, service mark or trade dress infringement, unfair competition, dilution or tarnishment.

**INTERROGATORY NO. 10**

For each and every product and service now or ever sold under South Cone's Reef Marks in the United States, state South Cone's annual U.S. sales by unit and dollar amount for each year since South Cone alleges its South Cone Reef Marks were first used.

**INTERROGATORY NO. 11**

For each good or service now or ever offered or promoted or distributed by South Cone in the United States under the South Cone Reef Marks, state in U.S. dollars the amount South Cone has expended annually promoting each of those goods and services for each year since first use; stating the types of advertising or promotional media employed; the geographic regions of the United States in which each type of media was employed; and the amount expended each year for each type of media.

**INTERROGATORY NO. 12**

Describe in detail South Cone's contention as to the ordinary purchasers or expected ordinary purchasers of the goods and/or services sold or to be sold under the Parties' Marks (see Definitions and Instructions) including without limitation, South Cone's contention as to the level of care likely to be exercised by such ordinary purchasers in purchasing the goods and/or services sold under the Parties' Marks.

**INTERROGATORY NO. 13**

Identify all officers, directors or employees of South Cone, Inc. from its inception to the present, most knowledgeable as to the use in commerce, as that term is defined in Section 45 of the Lanham Act, of products or services under the South Cone Reef Marks by providing their name, title and years of employment with South Cone, Inc., and the specific products and or services for which they are most knowledgeable.

**INTERROGATORY NO. 14**

Identify each and every person, including without limitation outside design agencies and employees of South Cone, who participated in the decision to adopt any marks or designations consisting of or including the term REEF for swimwear, and whether such persons were aware of Swimwear Anywhere's use or registration of the Swimwear Anywhere marks for swimwear at the time South Cone first adopted the South Cone Reef marks for swimwear.

**INTERROGATORY NO. 15**

State the inclusive dates during which South Cone first and has continued to use the South Cone REEF marks for swimwear, not including footwear and sandals, and identify all documents in South Cone's possession evidencing such first and continuing use.

**INTERROGATORY NO. 16**

State with particularity all information in support of South Cone's affirmative defenses in South Cone's Answers to Swimwear Anywhere's Counterclaim.

**INTERROGATORY NO. 17**

State with particularity all information in support of the denials in South Cone's Answer's to Swimwear Anywhere's Counterclaims.

**INTERROGATORY NO. 18**

State with particularity all information in support of South Cone's contention in South Cone's Notice of Opposition that Swimwear's Marks so resemble the South Cone's Reef Marks that they are likely, when used in connection with the goods and services of South Cone to cause confusion or to cause mistake, or to deceive, or would otherwise be damaging to South Cone.

**INTERROGATORY NO. 19**

State with particularity all information in support of South Cone's contention in South Cone's Notice of Opposition that registration of Swimwear Anywhere's Marks violates Section 43(c)(1-2) of the Trademark Act.

**INTERROGATORY NO. 20**

For each witness named in South Cone's initial disclosures, state in detail the substance of the facts and or opinions about which the witnesses named is expected to have discoverable information.

**INTERROGATORY NO. 21**

State the year on which South Cone contends that the South Cone Reef marks became famous within the meaning of Section 43(c)(2).

**INTERROGATORY NO. 22**

For each Request For Admission served in these proceedings to which South Cone now or ever responds with anything other than an unqualified admission, state all facts and legal contentions known to South Cone, and identify all documents in South Cone's possession, custody or control providing the factual basis for the failure to make an unqualified admission.

**INTERROGATORY NO. 23**

Identify those persons who had more than a clerical role in the answering of the foregoing interrogatories or in any search for documents in connection with said interrogatories or Swimwear Anywhere's Request for Production of Documents and beside the name of each such person, state the number of the interrogatory answer(s) with respect to which that person participated in or supplied information.

Respectfully submitted,

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Dated: August 5, 2011